

This response is being filed within five (5) months from the mailing date of the Office Action and a Petition for an Extension of Time is filed herewith along with the appropriate fee.

### **I. Specification**

The specification was objected to as failing to provide proper antecedent basis for the claimed subject matter. The specification is hereby amended to include the limitation that the scenting members do not require manual activation to function.

### **I. Claim Rejections – 35 USC §112**

The Office Action rejected Claims 1, 4, 19 and their dependents under 35 USC 112, first paragraph, as containing new matter which was not described in the original disclosure. The limitations that the scenting element “does not require activation” or a scent element “not requiring activation” by manual means are negative limitations. As such, a lack of literal basis in the specification for a negative limitation may not be sufficient to establish a *prima facie* case for lack of descriptive support. *Ex parte Parks*, 30 USPQ2d 1234, 1236 (Bd. Pat. App. & Inter. 1993). Applicant’s scenting elements do not require manual activation and, therefore, the negative limitation is not positively recited in the disclosure. Contradictorily, if Applicant’s scenting elements required manual activation, that positive limitation would be recited in the disclosure. Accordingly, Applicant has amended the specification to positively recite the negative limitation that Applicant’s scent elements do not require activation and respectfully requests the withdrawal of the rejection.

The Office Action rejected Claims 1, 14, and 19 under 35 USC 112, first paragraph, as containing subject matter which was not described in the specification in such a way to enable one skilled in the art to make and/or use the invention. As set forth in greater detail above, the negative limitation regarding the lack of activation of the fragrant elements is inherently within the Applicant's disclosure. Accordingly, Applicant has amended the specification to further clarify the negative limitation. As a result, Applicant respectfully requests the withdrawal of the rejection.

## **II. Claim Rejections – 35 USC §102**

The Office Action rejected **Claim 1** under 35 USC 102(b) as being anticipated by West US Pat. No. 5,572,800 ("West"). Applicant respectfully traverses the rejection and asserts that Claim 1 is novel and patentable in view of the remarks and/or amendments set forth herein.

It is well settled that an anticipatory reference must teach each and every one of the limitations of the claim(s) alleged to be anticipated thereby. For purposes of illustration but not limitation, West fails to disclose the first member of Applicant's claim that traverses the opening created by the frame that is attachable to the outside of the airflow conduit. Conversely, West's device is received within a main body section 20 which is then attached to barrel 10 of the blow drier and fails to traverse the opening created by the frame.

Applicant notes with appreciation that the rejection of Claims 11 and 12 under West was

withdrawn.

Therefore, because West fails to disclose all of the limitations of Applicant's invention as claimed, Applicant respectfully requests withdrawal of the rejection of Claim 1 thereunder.

The Office Action rejected **Claims 1, 2, 5 and 7** under 35 USC 102(b) as being anticipated by Russo US Pat. No. 5,649,370 ("Russo"). Applicant respectfully traverses the rejection and asserts that the claims are novel and patentable in view of the remarks and/or amendments set forth herein.

It is well settled that an anticipatory reference must teach each and every one of the limitations of the claim(s) alleged to be anticipated thereby. For purposes of illustration but not limitation, Russo fails to disclose at least Applicants limitation set forth in Claim 1 wherein the scenting element traverses the opening created by the frame. Conversely, Russo's device attaches to the peripheral wall 54 of the cup member 54. Claim 2 depends from allowable Claim 1 and incorporates the novel limitations thereof, and is in turn allowable.

Applicant's Claim 5 incorporates the novel limitations of Claim 1 and is therefore allowable because those limitations are not taught by Russo. Russo fails to disclose such a frame having the scenting elements maintained between the first and second layers that traverse the frame. Claim 7 also depends from Claim 1 and incorporates the novel limitations thereof and further discloses numerous limitations for the attaching means which are neither taught nor contemplated by Russo. Russo fails to teach Applicant's hook and loop fasteners, "S" hook

fasteners, pins, barbs, clips, clamps, adhesives, or tapes.

Applicant notes with appreciation that the rejection of Claims 11 and 12 under Russo were withdrawn.

Therefore, because Russo fails to disclose all of the limitations of Applicant's invention as claimed, Applicant respectfully requests withdrawal of the rejection of Claims 1, 2, 5, and 7 thereunder.

Applicant further notes with appreciation that the rejection of Claims 1, 2, 4, 5, 7-10, 13-16, and 18-20 under 35 USC 102(b) as being anticipated by McDowell was withdrawn.

### **III. Claim Rejections – 35 USC §103(a)**

The Office Action rejected **Claims 11 and 12** under §103(a) as being unpatentable over West or Russo in view of US Pat. No. 5,698,166 to Wonka et al. ("Vick"). Applicant respectfully traverses the rejection and the modification, combination and interpretation of the references.

It is well settled that in order for a modification or combination of the prior art to be valid, the prior art itself must suggest the modification or combination. None of the references suggests a reason to modify and combine the references as proposed. West, Russo and Wonka are individually complete and functional independently for their respective specific limited

purpose, and there would be no reason to make the modification or combination proposed by the Office Action.

Second, even if the modification and combination were legally justified, it still would not render Applicant's claimed invention obvious. Applicant's claimed invention teaches having a scent device extending across a frame that is attached to the inlet of an air flow conduit. As admitted by the office action, Russo and West fail to teach the attachment of the scenting device to the inlet opening. The combination of Wonka fails to overcome the failure. Wonka specifically states that the an air filter 54 is placed over the inlet and does not suggest the combination of a scenting element therewith.

Third, Applicant respectfully submits that the Office Action is improperly using "hindsight" and the teachings of Applicant's own claimed invention in order to modify West or Russo and Wonka to render Applicant's claims obvious. The Office Action admits that Russo and West fail to teach the scenting device being attached to the inlet. However, the Office Action improperly attempts to modify and combine Wonka, which also fails to teach Applicant's limitations, in an attempt to achieve Applicant's claimed invention.

Finally, if Applicant's claimed invention were in fact obvious, those skilled in the art would have modified Russo or West and Wonka to implement the advantages of Applicant's claimed invention. The fact that the Russo and West function by attachment to the outflow opening, there would be no motivation to move either to the inlet opening or to further modify Wonka in order to do so.

Accordingly, Applicant respectfully requests withdrawal of the rejection of Claims 11 and 12 under West or Russo in view of Wonka for at least the aforementioned reasons.

The Office Action rejected **Claims 1-5, 7-10, 13-16, and 18-20** under 35 USC 103(a) as being unpatentable over McDowell in view of Vick et al. ("Vick"). Applicant respectfully traverses the rejection, combination, and modification of the references and asserts that the claims are unobvious in view of the remarks and/or amendments set forth herein.

The rejection of the instant claims under 35 USC §102(b) in view of McDowell were withdrawn from the previous Office Action and have been reasserted hereunder in relation to the §103(a) rejection. Accordingly, the instant Office Action impliedly and expressly admits that McDowell fails to teach all of the limitations of Applicant's invention and attempts to combine Vick in an attempt to render Applicant's claims obvious.

It is well settled that in order for a modification or combination of the prior art to be valid, the prior art itself must suggest the modification or combination. Neither McDowell nor Vick suggests a reason to modify and combine the references as proposed. McDowell and Vick are individually complete and functional independently for their respective specific limited purpose, and there would be no reason to make the modification or combination proposed by the Office Action.

Second, even if the modification and combination were legally justified, it still would not

render Applicant's claimed invention obvious. Applicant's claimed invention teaches having a scent device extending across a frame that is attached to an air flow conduit. The attachment of Applicant's device may be in a region that is not easily accessible. Whereas, Russo must be attached in an easily accessible location to allow manual activation thereof. In addition, Applicant's Claim 5 has the further limitation of the scenting element being incorporated into a first and second layer enclosed peripherally by the frame. McDowell fails to teach enclosing the scenting elements between the first and second layers as taught by Applicant, because McDowell's scenting elements need to be ruptured by pressure from a human hand. Claim 7 also depends from Claim 1 and incorporates the novel limitations thereof and further discloses numerous limitations for the attaching means which are neither taught nor contemplated by McDowell. The combination of Vick fails to overcome the failure.

Third, Applicant respectfully submits that the Office Action is improperly using "hindsight" and the teachings of Applicant's own claimed invention in order to modify McDowell and Vick to render Applicant's claims obvious. The Office Action admits that McDowell fails to teach the scenting device being activated without the need for manual activation. However, the Office Action improperly attempts to modify and combine Vick, which also fails to teach Applicant's limitations, in an attempt to achieve Applicant's claimed invention.

Finally, if Applicant's claimed invention were in fact obvious, those skilled in the art would have modified McDowell and Vick to implement the advantages of Applicant's claimed invention.

Therefore, for at least the aforementioned reasons, Applicant respectfully requests withdrawal of the rejection of Claims 1-5, 7-10, 13-16, and 18-20 under McDowell in view of Vick.

The Office Action rejected **Claims 6** under §103(a) as being unpatentable over McDowell in view of Vick and in further view of Ward US Pat. No. 5,087,273 ("Ward"). Applicant respectfully traverses the rejection and the modification, combination, and interpretation of the references.

Applicant notes that Vick is newly added to the instant rejection in light of Applicant's previously filed response to the rejection of Claim 6 under McDowell in vie of Ward alone. It is well settled that in order for a modification or combination of the prior art to be valid, the prior art itself must suggest the modification or combination. None of the references suggests a reason to modify or combine the references as proposed. Each reference is individually complete and functional independently for its limited specific purpose and there would be no reason to make the modification and combination proposed by the Office Action.

Secondly, even if the modification was legally justified, it still would not render Applicant's invention obvious. Applicant's invention teaches the use of a scenting element that is spherical. As admitted by the Office Action, McDowell and Vick fail to teach a spherical scenting element, and Ward teaches a plurality of small beads in close proximity to one another, thereby defeating the greater volume to surface area ratio obtained by Applicant's invention.



Thirdly, the Office Action is improperly using "hindsight" and the teachings of Applicant's claimed invention in order to combine references to render Applicant's claims obvious. The Office Action admits that McDowell and Vick fail to teach the spherical scenting element limitation of Applicant's invention. However, the Office Action improperly attempts to modify and combine Ward, which also fails to teach all of the limitations of Applicant's invention, with McDowell and Vick in an attempt to achieve Applicant's invention.

Fourthly, the Office Action seems to recognize the advantages of the present invention by trying to make modifications in McDowell, Vick and Ward in an attempt to meet the advantages of Applicant's invention. Applicant respectfully submits that the fact the modification produces advantages taught by Applicant militates in favor of Applicant because it proves that the combination produces new and unexpected results and hence is unobvious.

Finally, if Applicant's invention were in fact obvious, those skilled in the art would have combined McDowell, Vick and Ward by now to implement the advantages of Applicant's invention. The fact that the two references have not been modified or combined to implement Applicant's invention, despite its admitted advantages, indicates that Applicant's invention is not obvious.

Accordingly, Applicant respectfully requests withdrawal of the rejection of Claim 6 under McDowell and Vick in view of Ward for at least the aforementioned reasons.

The Office Action rejected **Claim 17** under §103(a) as being unpatentable over McDowell in view of Vick and in further view of Frignon US Pat. No. 4,563,333 ("Frignon"). Applicant respectfully traverses the rejection and the modification, combination, and interpretation of the references.

Applicant notes that Vick has been newly added to the instant rejection, which in the previous Office Action was based on McDowell in view of Frignon. It is well settled that in order for a modification or combination of the prior art to be valid, the prior art itself must suggest the modification or combination. None of the references suggests a reason to modify or combine the references as proposed. Each reference is individually complete and functional independently for its limited specific purpose and there would be no reason to make the modification and combination proposed by the Office Action.

Secondly, even if the modification was legally justified, it still would not render Applicant's invention obvious. Applicant's invention teaches the use of a rigid material for the frame that is made of any rigid material including, but not limited to, cardboard and plastic. As admitted by the Office Action, McDowell and Vick fail to teach the use of cardboard or plastic in the frame, and Frignon only teaches the use of cardboard. As a result, the references, even if legally combined, would not render Applicant's claim obvious.

Thirdly, the Office Action is improperly using "hindsight" and the teachings of Applicant's claimed invention in order to combine references to render Applicant's claims obvious. The Office Action admits that McDowell and Vick fail to teach the rigid frame

limitation of Applicant's claim. However, the Office Action improperly attempts to modify and combine Frigon, which also fails to teach all of the limitations of Applicant's invention, with McDowell and Vick in an attempt to achieve Applicant's invention.

Fourthly, the Office Action seems to recognize the advantages of the present invention by trying to make modifications in McDowell, Vick and Frigon in an attempt to meet the advantages of Applicant's invention. Applicant respectfully submits that the fact the modification produces advantages taught by Applicant militates in favor of Applicant because it proves that the combination produces new and unexpected results and hence is unobvious.

Finally, if Applicant's invention were in fact obvious, those skilled in the art would have combined McDowell, Vick and Frigon by now to implement the advantages of Applicant's invention. The fact that the references have not been modified or combined to implement Applicant's invention, despite its admitted advantages, indicates that Applicant's invention is not obvious.

Accordingly, Applicant respectfully requests withdrawal of the rejection of Claim 17 under McDowell in view of Vick and in further view of Frigon for at least the aforementioned reasons.

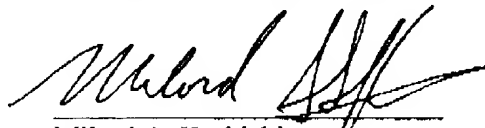
**CONCLUSION**

It is respectfully submitted that the case is now in condition for allowance, and an early notification of the same is requested. If it is believed that a telephone interview will help further the prosecution of this case, Applicant respectfully requests that the undersigned attorney be contacted at the listed telephone number.

Respectfully submitted,

MILORD & ASSOCIATES, P.C.

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**VERSION WITH MARKINGS TO SHOW CHANGES MADE**

**In the specification:**

In one preferred embodiment, first member 12 receives a coating with a particular fragrance through a dipping process wherein a fragrant media is in a liquid state and first member 12 is immersed therein. The liquid state is usually obtained through heating to a predetermined temperature as is known in the art. Upon removal of first member 12 from the fragrant media, excess media may be removed therefrom through agitation such that the interstices of first member 12 are not obscured thereby. The fragrant media forms a solid state as a result of the lowered temperature and is accordingly maintained upon first member 12. The fragrant media does not require further activation by manual or other means. Upon installation, a predetermined fragrance is emitted from the fragrant media.

Now also referring to Figure 8, an alternate preferred embodiment is illustrated for incorporating at least a fragrant element 24 within first member 12. A plurality of fragrant elements 24 may be enclosed within two layers of first member 12 and maintained therein by the peripheral attachment of frame 14. The fragrant element 24 does not require further activation by manual or other means. Upon installation, a predetermined fragrance is emitted from the fragrant element 24. The size of the fragrant elements 24 may be used to dictate the length of time that the fragrance will emanate therefrom as determined by the surface-to-volume ratio. For example, the surface area (s) of a sphere is proportional to the square of the sphere's radius (r). The volume (v), however, is proportional to the cube of the radius (r). Accordingly, as spheres increase in volume, their surface area increases only as the 2/3 power of the volume, signifying

that the increase in area is less than fully proportional to that in volume. Thus, bigger spheres have less surface area per unit of volume than little spheres and therefore bigger spheres sublimate at a lower rate than little spheres and last longer than little spheres.

**In the claims:**

1. (Twice Amended) A scenting device for use with an airflow conduit, comprising  
a first member having a scent that does not require activation;  
a frame enclosing said first member at a periphery thereof; and  
an attaching means on said frame for attaching the device to the airflow conduit;  
whereby said first member traverses said frame.
2. The device of Claim 1, wherein said first member is porous.
3. The device of Claim 1, wherein said scent is applied to said first member by  
immersing said first member in a liquid composition having said scent and upon withdrawal of  
the first member, said liquid solidifying upon said first member.
4. The device of Claim 1, wherein said first member is a fibrous material consisting of at  
least fiber glass.
5. The device of Claim 1, wherein said first member is comprised of a first layer and a

second layer and at least a scenting element is maintained between said first layer and said second layer upon installation of said frame.

6. The device of Claim 5, wherein said scenting element is spherical.

7. The device of Claim 1, wherein said attaching means is selected from a group consisting of hook and loop fasteners, "S" hook fasteners, pins, barbs, clips, clamps, adhesives, and tapes.

8. The device of Claim 1, wherein said attaching means is connected to an air filter within said airflow conduit selected from a group consisting of at least a heating, an air conditioning, and ventilating system.

9. The device of Claim 1, wherein said attaching means further comprises a mounting means having a substantially "U" shaped member having an inwardly opening groove of sufficient size to accommodate said frame in a slidingly removable manner.

10. The device of Claim 9, wherein said attaching means is placed on the mounting means and the mounting means is thereby attached to an air flow conduit.

11. The device of Claim 1, wherein said attaching means removably attaches said device to an inlet of an airflow based dryer means.

12. The device of Claim 11, wherein said air flow based dryer means is a blow dryer and said inlet is an air intake opening.

13. The device of Claim 10, wherein said mounting means is attached to a vent having a plurality of slotted openings such that said first member is maintained over said plurality of slotted openings.

14. A scenting device adapted for use in a heating, air conditioning, and ventilating system, the device comprising:

a first member having a scent element not requiring activation by manual means;

a frame enclosing said first member at a periphery thereof; and

a mounting means removably receiving said frame therein, and said mounting means having an attaching means for attachment thereof to the heating, air conditioning, and ventilating system.

15. The device of Claim 14, wherein said mounting means is substantially "U" shaped and has an inwardly opening groove of sufficient depth to accommodate said frame in a slidingly removable manner.

16. The device of Claim 14, wherein mounting means is substantially rigid.

17. The device of Claim 14, wherein said frame is made of a substantially rigid material selected from a group consisting of cardboard and plastic.



18. The device of Claim 14, wherein said first member is substantially porous to allow airflow therethrough.

19. In combination, a scenting device having a scented, porous first member enclosed by a frame around a periphery thereof, and a vent cover for receiving the scenting device;

the scenting device having a scent element not requiring manual activation;

the vent cover further comprising a front surface, said front surface defining a plurality of slotted openings therein;

a peripheral wall extending in a rearward direction from said front surface;

an aperture being defined on a portion of said peripheral wall;

whereby said aperture is adapted to receive the scenting device in a removable, yet secure, manner such that the frame occludes the aperture when the scenting device is installed.

20. The combination of claim 19, wherein the vent cover further comprises at least a retaining means that traverses across substantially opposing portions of said wall such that the scenting device is maintained between the front surface and said retaining means.